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EXAMINER VILLECCO, JOHN M				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/587,117

Applicant(s)

SENDA, AYUMI

Examiner

JOHN M. VILLECCO

Art Unit

2622

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11 is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-10 and 12-14 is/are rejected.
- 7) ☒ Claim(s) 5 and 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB-08)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

1. Claim(s) 12-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claims 12-14 define a program embodying functional descriptive material. However, the claims do not define a computer-readable medium or memory and is thus non-statutory for that reason (i.e., "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the

function of the descriptive material to be realized” – Guidelines Annex IV). That is, the scope of the presently claimed program can range from paper on which the program is written, to a program simply contemplated and memorized by a person. Applicant is reminded that there must be support for any amendment intended to overcome this rejection.

Claim Objections

2. Claim 8 is objected to because of the following informalities:
 - In line 1 of claim 8, applicant recites the phrase “In image pickup system”. This appears to be a typographical error and that the applicant meant to use the phrase – An image pickup system –.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claim 6-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claim 6 recites the limitation "the image pickup means" in line 6. There is insufficient antecedent basis for this limitation in the claim. Previously applicant had referred to an image pickup device. It is not clear if these are the same.
6. Claim 7 is rejected based on its dependency to claim 6.

7. Claim 8 recites the limitation "the image pickup means" in line 29. There is insufficient antecedent basis for this limitation in the claim. Previously applicant had referred to an image pickup device. It is not clear if these are the same.

8. Additionally, claim 8 recites the limitations of a "first connection detecting means" and a "second connection detection means". However, after a review of the specification, it is clear that applicant's invention only claims one connection detection means —power detection circuit, 203. Thus, applicant has failed to particular point out and distinctly claim the subject matter which applicant regards as the invention. For examination purposes it will be assumed that there is only one connection detection means.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 2, 6, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by

Endo (U.S. Publ. No. 2002/0051639).

11. Regarding *claim 1*, Endo discloses a camera connected to a cradle in which images stored in the camera can be transferred to the cradle for backup. More specifically and as it relates to the applicant's claims, Endo discloses an image pickup means (image pickup, 14) for picking up an image; control means (CPU, 20) for permitting image data, corresponding to the image picked up by the image pickup means (image pickup, 14) to be recorded in a given record medium

(flash memory, 34) or a given external record device (cradle, 50); connection means (power supply connector, 52, and data connector, 54) for connection to the external record device (cradle, 50); connection detecting means (power supply detection circuit, 60) for detecting a connection to the external record device (cradle, 50) through the connection means; and transfer processing means (control, 64) controlled by the control means (CPU, 20) for transferring the image data, recorded in the record medium (flash memory, 34) to the external record device when the connection detection means detects the connection to the external record device. See paragraphs 0056 and 0064 and 0074.

12. As for *claim 2*, Endo discloses that the image data in the flash memory (34), which was captured by the image pickup means, is recorded to the external record device (cradle, 50) when the camera is connected to the external record device (cradle, 50).

13. Regarding *claim 6*, Endo discloses a camera connected to a cradle in which images stored in the camera can be transferred to the cradle for backup. More specifically and as it relates to the applicant's claims, Endo discloses a connection means (power supply connector, 52, and data connector, 54) connectable to an image pickup device (camera); a connection detecting means (power supply detection circuit, 60) for detecting that the image pickup device is connected by the connection means (paragraph 0056); a readout means (CPU, 20) for reading out image data, picked up by the image pickup device, through the connection means (data connector, 54) when the connection detecting means (power supply detection circuit, 60) detects that the image pickup device is connected (paragraph 0074); and a saving means (backup HDD, 62) for saving the image data read out by the readout means.

14. With regard to *claim 8*, Endo discloses a camera connected to a cradle in which images stored in the camera can be transferred to the cradle for backup. More specifically and as it relates to the applicant's claims, Endo discloses an image pickup means (image pickup, 14) for picking up an image; control means (CPU, 20) for permitting image data, corresponding to the image picked up by the image pickup means (image pickup, 14) to be recorded in a given record medium (flash memory, 34) or a given external record device (cradle, 50); connection means (power supply connector, 52a, and data connector, 54a) for connection to the external record device (cradle, 50); connection detecting means (power supply detection circuit, 60) for detecting a connection to the external record device (cradle, 50) through the connection means; and transfer processing means (system bus, 44) controlled by the control means (CPU, 20) for transferring the image data, recorded in the record medium (flash memory, 34) to the external record device when the connection detection means detects the connection to the external record device. Additionally, Endo discloses a connection means (power supply connector, 52b, and data connector, 54b) connectable to an image pickup device (camera); and a saving means (backup HDD, 62) for saving the image data read out by the readout means. See paragraphs 0056 and 0064 and 0074.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. **Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Endo (U.S. Publ. No. 2002/0051639) in view of Fujimoto (Japanese Publ. No. 06-022259 A).**

17. Regarding *claim 7*, as mentioned above in the discussion of claim 6, Endo discloses all of the limitations of the parent claim. Additionally, Endo discloses that the saving means is a hard disk device (HDD, 62; paragraph 0056). Endo, however, fails to specifically disclose a speed control means for decreasing a rotational speed of a platter forming the hard disk device when a voice is recorded under a condition in which the image pickup device is connected. Fujimoto, on the other hand, discloses that it is well known in the art to decrease the rotational speed of a platter when recording voice. More specifically, Fujimoto discloses a speed control means (revolution control circuit, 110) for lowering the rotational speed of a platter (video floppy disk, 112) when a voice is recorded. Fujimoto discloses that this is done so that the number of picked up recording sheets is not reduced. See the abstract. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to reduce the rotational speed of the platter of the hard disk device in Endo when recording voice so that the number of recording sheets is not reduced.

18. **Claims 3, 4, 9, 10, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Endo (U.S. Publ. No. 2002/0051639) in view of Terane (U.S. Publ. No. 2003/0076440) and further in view of Nanba (U.S. Patent No. 6,297,870).**

19. Regarding *claim 3*, as mentioned above in the discussion of claim 1, Endo discloses all of the limitations of the parent claim. Endo, however, fails to explicitly disclose judgment means for making judgment depending on a size of the image data and an available memory of the

record medium whether or not the record medium is able to store the image data; wherein the control means allows the image data to be saved in the record medium or to be transferred to the external record device through the transfer processing means depending on a judgment result of the judgment means. This feature implies that the camera is capable of capturing an image when placed in the cradle. Terane discloses that it is well known in the art to allow a camera to capture an image when place in a cradle. See Figure 7 and paragraphs 0117-0123. Such a feature would allow for the capture of an image while the camera is charging. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the camera of Endo to capture an image while it is positioned in the cradle.

Furthermore, Nanba, on the other hand, discloses that it is well known to store an image to external memory if there is not enough internal memory to store it. More specifically, Nanba discloses a camera (1) connectable to an external storage device (computer, 1000). When it is judged that the memory card of the camera can not hold a captured image, an image is transferred to the PC (1000) for storage. See Figures 6A and 6B and column 7, line 32 to column 8, line 23. Therefore, it would have been obvious to one of ordinary skill in the art to store an image into external memory if there is not enough memory in the internal memory in the camera of Endo so that the image capturing operation can be successfully carried out. See column 10, lines 1-10.

20. As for *claim 4*, Nanba discloses that if there is sufficient memory in the recording medium (memory card, 8) then the image is stored in the memory card, not the computer (1000). See Figures 6A and 6B.

21. **Claim 9** is considered a method claim corresponding to claim 4. Please see the discussion of claim 4 above.
22. **Claim 12** is considered a computer program claim corresponding to claim 4. Please see the discussion of claim 4 above.
23. **Claim 10** is considered a method claim corresponding to claim 4. Please see the discussion of claim 4 above.
24. **Claim 13** is considered a computer program claim corresponding to claim 4. Please see the discussion of claim 4 above.

Allowable Subject Matter

25. Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

Regarding claim 5, the primary reason for indication of allowable subject matter is that the prior art fails to teach or reasonably suggest that the control means is operative such that under a situation where the image pickup device is connected to the external record device through the connection means when the image data is recorded in the recording medium under a given file name, other image data related to the image data is recorded in the external record device under another file name for consolidation to the image data recorded under the given file name.

26. Claim 11 is allowed.
27. The following is an examiner's statement of reasons for allowance:

Regarding claim 11, the primary reason for allowance is that the prior art fails to teach or reasonably suggest a step of detecting whether or not the image pickup device is connected to the hard disk device, a step of detecting that the image pickup device has a voice input, and a step of recording the image data upon decreasing a platter rotational speed of the hard disk device if the image pickup device is connected to the hard disk device and the image pickup device has the voice input when the image pickup is commanded.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN M. VILLECCO whose telephone number is (571)272-7319. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on (571) 272-7564. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JOHN M. VILLECCO/
Primary Examiner, Art Unit 2622
February 26, 2009